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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY S. WALKER, JAMES A. JORASCH,
RUSSELL P. SAMMON, STEPHEN C. TULLEY, and
STEVEN M. SANTISI

Appeal 2009-014230
Application 10/685,143
Technology Center 3700

Before LINDA E. HORNER, JOHN C. KERINS, and
EDWARD A. BROWN, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jay S. Walker et al. (Appellants) appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1-6, 21-26, 36-40, 55, and 56. (App. Br. 5). Claims 7-20, 27-35, and 41-54 were canceled. (*Id.*). We have jurisdiction over this appeal under 35 U.S.C. § 6(b). We AFFIRM-IN-PART and enter New Grounds of Rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

THE INVENTION

The invention is directed to methods for providing messages to players at a gaming machine. (Spec. 3:18-20). Independent claim 1, reproduced below, is illustrative of the appealed subject matter.

1. A method, comprising:
 - determining a message;
 - identifying a game machine;
 - determining gaming activity associated with a player;
 - determining a feature of the game machine, the feature being selected based on the gaming activity,
 - wherein the feature comprises a feature that may be activated based on a selection by the player; and
 - outputting the message to a player via the game machine, the message comprising a recommendation of the feature.

THE REJECTIONS

The following rejections are before us on appeal for review.

1. Claims 1-6, 21-26, and 55 are rejected under 35 U.S.C. § 102(e) as anticipated by, or alternatively under 35 U.S.C. § 103(a) as being unpatentable over, LeMay (US 6,942,574 B1, issued Sep. 13, 2005).
2. Claims 36-40 are rejected under 35 U.S.C. § 102(e) as anticipated by LeMay.
3. Claim 56 is rejected under 35 U.S.C. § 103(a) as being unpatentable over LeMay and Fuchs (US 6,126,541, issued Oct. 3, 2000).

ANALYSIS

Claims 1-6, 21-26, and 55 – anticipation / obviousness over LeMay

Claims 1-6 and 21-26

Claim 1 recites a method comprising "determining a feature of the game machine . . . wherein the feature comprises a feature that may be activated based on a selection by the player"; and "outputting the message to a player via the game machine, *the message comprising a recommendation of the feature.*" (Emphasis added). The Examiner found (Ans. 3, 7) that LeMay discloses:

[A] . . . method of providing entertainment content on a gaming machine [which] may be characterized as including: 1) displaying a list of one or more entertainment content sources, 2) receiving a selection of the entertainment content source from said list and 3) outputting the entertainment content from the selected entertainment content source to an output device. . . . Additionally, the method may include, a) *prior to outputting the entertainment content,*

determining an indicia of credit amount for the selected entertainment content source, b) displaying a message on the display device notifying a player of the required indicia of credit amount and c) initiating the selected entertainment content when the required indicia of credit amount is available on the gaming machine or i) prior to receiving the selection, receiving player tracking information and ii) allowing access to the entertainment content sources based upon the player tracking information.

(LeMay col. 3, ll. 4-23) (emphasis added).

The Examiner determined that LeMay discloses the claimed "outputting" step in that "the system outputs a message advising of the various cost of the feature." (Ans. 3). We understand that the Examiner determined that LeMay's selected entertainment content source corresponds to the claimed "feature," and "displaying a message on the display device notifying a player of the required indicia of credit amount" corresponds to the claimed "outputting." (*Id.* at 7). The Examiner stated "LeMay discloses recommending to the player that for the feature [there] is a cost attached, thus informing of the pros and cons of the feature, the choice left to the player to continue. (*Recommend i.e.; to advice [sic] or counsel*)."
(*Id.*) (emphasis added). Alternatively, the Examiner determined that it would have been obvious to one of ordinary skill in the art "to interpret an advise [sic] of cost as recommendations regarding the feature." (Ans. 3).

Appellants contend that LeMay does not disclose "recommending" a feature of a gaming device, disagreeing with the Examiner regarding the

meaning of "recommend. (App. Br. 17; Reply Br. 4).^{1,2} Appellants contend that displaying a message notifying a player of required indicia of credit is an advisement of an attribute of a feature, but as no alternative is suggested, it is not a recommendation of anything. (Reply Br. 5).

Appellants' essential contention appears to be that LeMay's displayed message, which notifies a player of the required indicia of credit amount, does not provide the *same content* as the "recommendation of the feature" of the claimed message. Appellants do not appear to contest the Examiner's findings with respect to any other limitations recited in claim 1.

Appellants' contention raises the issue of whether claim 1, which is directed to a method, becomes novel because it comprises outputting a message having a particular content to a player via the game machine. The rationale underlying "printed matter" cases has been extended to the analysis of patentability of method claims. *King Pharmaceuticals Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1278-79 (Fed. Cir. 2010) (applying the "printed matter" reasoning to method claims containing an "informing" step that could be either printed or verbal instructions). In this case, the relevant question is whether the particular message that is output to a player has a "new and unobvious functional relationship" with the method. *Id.* at 1279. We do not find any functional relationship between the "message comprising a recommendation of the feature" and the method. Irrespective of the

¹ Appellants state "the most common usage of the verb 'recommend' is 'to present as worthy of confidence, acceptance, use, etc.; commend; mention favorably: *to recommend an applicant for a job; to recommend a book.*' (Dictionary.com)." (Reply Br. 4).

² Appellants state "the third most preferred usage of 'recommend' is 'to advise, as an alternative; suggest (a choice, course of action, etc.) as appropriate, beneficial, or the like'. (Dictionary.com)." (Reply Br. 4).

particular message output to the player, the actual method of determining and delivering a message to a player via a gaming machine, as defined by the remainder of the claim, is the same. The particular message does not depend on the method, and the method does not depend on the particular message. *See also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). As such, the recited content of the displayed message does not alone patentably distinguish the claimed method from LeMay. Accordingly, we sustain the rejection of claim 1 as anticipated by LeMay.

Regarding Appellants' contentions directed to the Examiner's alternative obviousness rejection of claim 1 (App. Br. 18), a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for anticipation is the epitome of obviousness. *See In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974); and *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982). Hence, we do not need to reach these contentions in this appeal.

Appellants do not argue any specific limitations recited in claims 2-6, but rely on their dependency from claim 1 for patentability. (App. Br. 19-21). Hence, we also sustain the rejection of claims 2-6 as anticipated by LeMay.

Independent claim 21 differs from claim 1 in that it does not recite the step of "identifying a game machine." The Examiner's findings and reasoning (Ans. 3, 7-8) and Appellants' arguments for patentability (App. Br. 15-19; Reply Br. 4-5) as to claim 21 are similar to those discussed *supra* for claim 1. Hence, we also sustain the rejection of claim 21 as anticipated by LeMay.

Appellants do not argue any specific limitations recited in claims 22-26, but rely on their dependency from claim 21 for patentability. (App. Br. 21-23). Hence, we also sustain the rejection of claims 22-26 as anticipated by LeMay.

Because our analysis differs from the Examiner's statement of the rejection of claims 1-6 and 21-26 such that Appellants have not had a fair opportunity to react to the application of the printed matter doctrine to the claims, we designate our affirmance of the rejection a New Ground of Rejection.

Claim 55

Independent claim 55 recites a method comprising steps of "determining an occurrence of a trigger condition," "identifying a message in a database of messages based on the trigger condition," "suppressing output of the message until a second trigger condition is satisfied," and "displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition." The Examiner appears to have determined that in LeMay, the "first trigger" is the system being triggered to send updates of games that the player selected to track, and the "second trigger" is payment. (Ans. 4). The Examiner also found that the "message" is the message notifying the player of the required indicia of credit. (*Id.*). The Examiner also found that in LeMay making a wager and that the wager be of a minimum amount correspond to first and second "triggers." (*Id.* at 9). In addition, the Examiner appears to have found that in LeMay the message being withheld until receiving player tracking

information and then allowing player access based on the tracking information are also two "triggers." (*Id.*).

We agree with Appellants that if the second trigger in LeMay is payment, then the "message" would appear to occur before payment, while claim 55 calls for the message to be suppressed until after the second trigger condition is satisfied. (App. Br. 25). We also agree with Appellants that making of a wager and the wager being of a minimum amount correspond at most to one trigger. (Reply Br. 6). We also agree with Appellants that the Examiner did not identify any disclosure in LeMay of identifying a message in a database of messages based on either of the "triggers," or the message being withheld until receiving player tracking information and then allowing player access based on the tracking information. (*Id.*). Rather, satisfaction of both of these "triggers" appears only to allow the player to see the list of entertainment content sources, which the Examiner did not find to be related to the above-discussed "message" in LeMay (i.e., notifying the player of the required indicia of credit). Hence, we do not sustain the rejection of claim 55 as anticipated by LeMay. The Examiner also did not articulate adequate reasoning why one of ordinary skill in the art would have modified LeMay to provide the claimed method, thus the rejection of claim 55 as unpatentable over LeMay is not sustained.

Claims 36-40 – anticipation by LeMay

Independent claim 36 recites a method comprising "determining a first representation of the message and a second representation of the message," "outputting the first representation of the message to a first player at a game machine," and "outputting the second representation of the message to a second player at a game machine." Claim 36 further recites

"wherein determining the first representation includes selecting a representation *based upon a characteristic of the first player*," and "wherein determining the second representation includes selecting a representation *based upon a characteristic of the second player*." (Emphasis added).

The Examiner found LeMay discloses:

[T]he television programming entertainment content may be displayed while a player is engaged in playing a game on the gaming machine or between games. Similarly, the [entertainment] content may include information available on the Internet, including the World Wide Web, for more technologically sophisticated players.

(Ans. 6, citing LeMay col. 4, ll. 61-67).

The Examiner determined that LeMay discloses "similar content as presented in TV format is available in WEB page format so that two players can view the same content in two different formats," and that "upon the player tracking information, player preferences are kept and for those more sophisticated players, the content will be sent in their preferred format."

(Ans. 6).

Appellants contend that LeMay does not disclose determining first and second representations of a single message, outputting the first and second representations of *the message* to a first player at a game machine and a second player at a game machine, and that "determining the first representation includes selecting a representation *based upon a characteristic of the first player*," and "determining the second representation includes selecting a representation *based upon a characteristic of the second player*." (App. Br. 27-28; Reply Br. 6-7) (emphasis added). We agree.

According to LeMay's disclosure relied on by the Examiner, television or internet content may be displayed to a first player at a gaming machine, and television or internet content may be displayed to a second player at a gaming machine. However, LeMay's disclosure does not explain that the television content or internet contents provides any particular message based on player characteristics. As such, assuming that the first player or the second player is "more technologically sophisticated," while the other player is not, LeMay does not disclose that first and second representations of the same message, based upon a characteristic of the respective first and second players, necessarily are determined and output to the players. Alternatively, assuming that television content or internet content is displayed to both the first player and the second player, again LeMay does not disclose that first and second representations of the same message, based upon a characteristic of the respective first and second players, necessarily are determined and output to the players. Hence, we do not sustain the rejection of claim 36 and dependent claim 37.

Independent claim 38 differs from claim 36 in that it recites "determining the first representation includes selecting a representation *based upon an indication* by the first player," and "determining the second representation includes selecting a representation *based upon an indication* by the second player." (Emphasis added). The Examiner's findings (App. Br. 6, 9, 10) and Appellants' contentions (App. Br. 28-29; Reply Br. 6-7) with respect to claim 38 are similar to those for claim 36. The Examiner determined that in LeMay the "indication" by a player is "whereas the system receives input of the selection from the player." (Ans. 6). We agree with Appellants that LeMay does not disclose that first and second

representations of the same message, based upon an indication by the respective first and second players, necessarily are determined and output to them. Hence, we do not sustain the rejection of claim 38 and dependent claim 39.

Independent claim 40 recites a method comprising "determining a message to be output to a player at a game machine; and suppressing output of the message, wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied." The Examiner found that LeMay discloses:

As described above, a player predetermined condition may include actions such as depositing money into the gaming machine or making a wager on a game where the wager is above some threshold amount. In 610, when at least one of the predetermined conditions is satisfied, the entertainment content may be output to an output device.

(Ans. 10, citing LeMay, col. 14, ll. 30-35). The Examiner determined that LeMay discloses the claimed method in that it discloses conditions to be satisfied prior to displaying content, thus delaying output. (Ans. 10). We understand that the Examiner determined that the entertainment content described in LeMay corresponds to the claimed "message," and actions such as depositing money or making a wager correspond to the claimed "trigger condition." (*Id.*).

Appellants do not address the Examiner's findings for this claim. (*See* Reply Br. 1-8). We agree with the Examiner that LeMay's disclosure that at least one predetermined condition needs to be met before the entertainment content may be output to an output device corresponds to the claimed step of "suppressing output of the message, wherein suppressing output of the

message includes delaying output of the message until a trigger condition is satisfied." We also agree with the Examiner that the message that is output would be a "determined" message. Hence, we sustain the rejection of claim 40.

Claim 56 – obviousness over LeMay and Fuchs

Claim 56 depends from claim 1 and recites that "the message further comprises: data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity." The Examiner found that LeMay discloses the method of claim 1 and relied on Fuchs for disclosure regarding the features of claim 56. However, we find that claim 56, like claim 1, also recites particular content of the displayed message, which does not alone patentably distinguish the claimed method from the combination of LeMay and Fuchs. Accordingly, claim 56 is anticipated by LeMay for the same reasons discussed *supra* for claim 1. Because anticipation is the epitome of obviousness, we sustain the rejection of claim 56, and designate our affirmance of the rejection as a New Ground of Rejection for the same reasons as claim 1.

DECISION

1. We AFFIRM the rejection of claims 1-6 and 21-26 as anticipated by LeMay and designate our affirmance of the rejection of these claims as a New Ground of Rejection, and REVERSE the rejection of claim 55 as anticipated by or being unpatentable over LeMay.

2. We REVERSE the rejection of claims 36-39, and AFFIRM the rejection of claim 40, as anticipated by LeMay.

3. We AFFIRM the rejection of claim 56 as being unpatentable over LeMay and Fuchs and designate our affirmance of the rejection as a New Ground of Rejection.

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains New Grounds of Rejection pursuant to 37 C.F.R. § 41.50(b), which provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options *with respect to the new grounds of rejection* to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this

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case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection(s), including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

MP